

Appl. No. 10/717,313
Amdt. Dated 4/07/2005
Reply to Office Action of January 7, 2005

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed January 7, 2005. The Examiner is thanked for his thorough examination.

In the Office Action, claims 12-19 were allowed and claims 8-9 were objected to as containing allowable subject matter, but being directed to a rejected base or intervening claim. Claims 12-19 have not been amended. Claim 8 has been placed into independent form to include most of the limitations from claim 1. Claim 22 has been added, which is identical to original claim 8. Claim 23 is equivalent to objected claim 9. Hence, claims 8-9 and 12-19 are in condition for allowance.

Claims 1-3, 5-7, and 20 were rejected under 35 U.S.C. §102(b), and claims 4, 10 and 11 were rejected under 35 U.S.C. §103(a). Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1-3, 5-7, and 20 were rejected under 35 U.S.C. §102(b) as being anticipated by Patel (U.S. Patent No. 6,418,017). Applicants respectfully traverse the rejection and contend that the Examiner has not met the burden of establishing a *prima facie* case of anticipation.

As the Examiner is aware, to anticipate a claim, the reference must teach each and every element set forth in the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Vergegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

Herein, Patel teaches the use of a heat pipe for cooling purposes. This particular heat pipe is integral to the chassis member (12) in order to avoid thermal contact resistance that reduces heat conductivity at connective junctions between the heat pipe and the chassis member (12). *See column 6, lines 7-16 of Patel*. In contrast with the teaching of Patel, the claimed apparatus features a cooling structure that comprises a liquid cooling path and a pump to assist in the circulation of coolant through the liquid cooling path. Besides the notable structural differences, the cooling efficiency of the liquid cooling path, combined with a pump, is far greater compared than the cooling capacity of the heat pipe as taught by Patel.

In light of the foregoing, Applicants respectfully request the Examiner to withdraw the outstanding §102(b) rejection.

Rejection Under 35 U.S.C. § 103

Claims 4, 10 and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Patel in view of Tomonori (JP 2002-344186). Claims 10 and 11 have been cancelled without

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prejudice. Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

As the Examiner is aware, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. See MPEP §2143; see also *In Re Fine*, 873 F. 2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Herein, at a minimum, the combined teachings of the cited references do not describe or suggest all the claim limitations set forth in dependent claim 4, which depends on intervening claims 1-3.

Applicants respectfully submit that Tomonori also comprises a heat pipe as a cooling structure for an electronic component that generates heat. Tomonori further comprises a corrugated exterior surface, which contains a heat pipe at a bottom surface of a body containing the electronic component. Hence, neither Patel nor Tomonori, alone or in combination, discloses a liquid cooling path, combined with a pump, as a cooling structure of the electronic component that generates heat. In fact, the combination of the cooling structures taught by Patel and Tomonori, each of which being a heat pipe, cannot be construed as a liquid cooling path combined with the pump.

Therefore, Applicants respectfully request that the outstanding §103(a) rejection be withdrawn.

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Conclusion

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Dated: 4/07/2005

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Susan McFarlane

4/07/2005

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